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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,082	11/05/1999	KEVIN J. RYAN	303.306US2	3448

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EXAMINER	
PEIKARI, BEHZAD	

ART UNIT	PAPER NUMBER
2186	33

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/434,082	Applicant(s) RYAN, KEVIN J.	
	Examiner B. James Peikari	Art Unit 2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *2/19/04* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-8 and 29-71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-8 and 29-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. This previous objection to Figure 6 is withdrawn due to the amendment.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 5-8 and 29-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katayama et al., U.S. 5,875,452, in view of Rosich et al., U.S. 5,587,964.

Katayama et al. teach the claimed invention in a memory system (*note especially Figure 9*) comprising:

a memory controller (*note memory controller 17, via controller 70*) with a unidirectional command and address bus (*note that the address and control lines from controller 70 to the decoders are all unidirectional*),

a bidirectional data bus (*note that data line 56 is bidirectional*), a plurality of memory devices, such as eight, (*note the use of up to sixteen exemplary DRAM devices 22*),

a shared command buffer (*note the registers A and B in controller 70, which are connected to each of the plurality of memory devices 22, as explained in column 26, lines 56-57*) coupled between the command and address bus (*18; note that bus 18 comprises, in part, a control bus and an address bus*) and the plurality of memory devices (*22*) for receiving and latching commands and addresses, and

a shared data buffer (*note data buffer 78*) connected between the plurality of memory devices (*22*) and the bidirectional data bus (*18; note that bus 18 comprises, in part, a data bus*) for receiving and latching read data or write data.

Note that each of the buffers has a characteristic delay associated with it, as do all buffers (hence, the name "buffer").

As for the claimed pipelined packet protocol, note column 2, lines 34 et seq. and column 20, line 6. [As to the meaning of "pipelined subsystems", it is clear from applicant's specification, page 8, lines 27-30, that this means that each subsystem 130 is pipelined within itself. It does *not* mean that each subsystem is one link in a larger pipeline.]

As for the feature of each memory device containing a column decoder and a row decoder, note column 26, lines 51-57.

As for the feature of each memory device containing a data in buffer and a data out buffer, such was not specifically mentioned in the Katayama et al. system. However the benefits of adding additional levels of buffer hierarchies was well known at the time of the invention. It would have been obvious to include data in and data out buffers for each of the memory devices 22 in the Katayama et al. system. In any case Rosich et al. teaches a DRAM device compatible with the Katayama et al. system and which explicitly teaches a data in buffer and a data out buffer associated with the storage array (note, e.g., Figure 1).

Note that both of the Rosich et al. buffers are *internal* to the DRAM (in fact, every element shown in Figure 1 is contained within DRAM 100).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the DRAM devices of Rosich et al. as the DRAM devices of Katayama et al., since buffers in the Rosich et al. DRAM would have made the timing of the transfer operations to and from the shared buffers more efficient (by latching the data, control or address bits so that such protocols as time sharing could be utilized), especially considering the highly parallel nature of the Figure 9 embodiment of the Katayama et al. system.

At this point it is apparent that the above Katayama et al./Rosich et al. combination teach each and all of the features of *one* of applicant's memory subsystems 130.N. On the other hand, each of applicant's embodiments include a *plurality* of such memory subsystems. In the remarks submitted with the amendment filed January 17, 2002, applicant has now clarified the scope of what is meant by "memory subsystem" (when the specification mentions "each memory subsystem 130" it does *not* mean all of the units which start with "130", it really means "each memory subsystem 130.N", i.e. each *one* of the units surrounded by dashed lines). The combination of references recited above does not specifically mention that memory controller 17 could be connected to *more than one* storage device 16. However, the benefits of adding extra memory were quite well known. Whether extra memory devices 16 were added in parallel, series or in some combinations thereof, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add such extra devices to the Katayama et al./Rosich et al. combination since (1) extra memory meant that more data could be stored, (2) several storage devices 16 linked in parallel would have allowed for faster data retrieval via parallel data transfers,

(3) it was noted in St. Regis Paper Co. v Bemis Co. 193 USPQ 8 (7th Cir. 1977) that to duplicate parts for multiple effects is *not* given patentable weight, and (4) the suggestion for plural memory devices is *within the Katayama reference itself* (note column 26, lines 30-45) – in this embodiment the DRAM arrays 22 become part of a larger array of up to 16 devices (in column 9, Katayama explicitly states that "it is preferable that the storage device has a plurality of the DRAM arrays"); consequently, the same motivations exist for integrating the storage device 90 into a larger array of such storage devices.

As to the specific feature of each of the command buffers being shared by the plurality of memory devices of each memory subsystem and positioned between the command and address bus and the plurality of memory devices of each memory subsystem, this is *exactly* how the Katayama et al./Rosich et al. combination would look if it were integrated in the manner described above by the examiner.

As to the specific feature of issuing and latching to a plurality of memory subsystems but retrieving data from only one of the memory subsystems (note, e.g., claim 56), this was how DRAMs operated. This was *fundamental* data access technique. For example, to execute a read operation, multiple memory locations must be searched and once the target data is found, it will be retrieved from the particular memory location that stores it.

Double Patenting

4. The previous rejections under the judicially created doctrine of obviousness-type double patenting are withdrawn due to the terminal disclaimer filed on February 19, 2004.

Response to Amendment

5. The declaration filed on February 19, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Katayama et al., U.S. 5,875,452, reference, for at least the following reasons:

(A) **Conception**: The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Katayama et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Applicant attempts to establish conception by the submission of an internal invention disclosure (Exhibit A), with dates redacted, but fails to explain how or why this document establishes conception. According to MPEP 715.07,

> The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Furthermore, with regard to the exhibit(s), the following are noted:

(1) In Exhibit A, the name of the witness that has signed the invention disclosure has not been provided.

(2) Another exhibit, in the form of notebook entries, has been submitted, but has not been referred to in the declaration. This exhibit has not been considered in accordance with MPEP 715.07 which states,

"Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show."

(B) **Reduction to Practice**: Reduction to practice has not been mentioned *at all* in the declaration. MPEP 715.07 explicitly states,

"The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and *completion* of invention" (emphasis added)

Furthermore, reduction to practice has not been shown in the exhibit(s):

(1) Exhibit A states "the proposed solution" in section 3.2(c).

(2) Exhibit A makes it clear that there was not even *experimental* use in section 3.4(a).

(C) **Diligence**: The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Katayama et al. reference to either a constructive reduction to practice or an actual reduction to practice.

(1) It is impossible to determine whether diligence has occurred without knowing the actual date of reduction to practice.

(2) Further, MPEP 715.07 explicitly states,

"the actual dates of acts relied on to establish diligence must be provided"

(3) the period from "prior to December 1996" (applicant's alleged date of conception) to July 1, 1997 (the priority date relied upon by applicant) is at least seven months. This means that at least seven months of evidence of diligence, including specific dates, are unaccounted for in the declaration.

(4) MPEP 715.07 further states,

"A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909)."

(5) Note all of MPEP 715.07(a).

6. On page 1 of the remarks attached to the amendment, applicant traverses and incorporates all prior responses. Hence, the following is repeated from the previous Office action.

With regard to the remarks submitted with the amendment filed July 17, 2003 these have been carefully considered but are not deemed convincing for at least the following reasons:

(A) With regard to the third paragraph on page 16 of the remarks, the examiner must respectfully refuse to comply with applicant's request for clarification, in accordance with MPEP 1701.

(B) As to applicant's remarks regarding claims 5-8 and 59-62 on page 17, the examiner must respectfully refuse to comply with applicant's request for clarification, in accordance with MPEP 1701.

(C) As to applicant's remarks regarding claims 29-31, applicant states "that claim 29 and its dependent claims 30-31 are allowable as all of the claim features are not found in Katayama and Rosich". However, each and every feature of the claims has been taught by the combination cited in the rejection above. The explanation provided above satisfies all of the criteria of MPEP 2142 for the combination. Furthermore, applicant has already stated *on the record* that it was well known to include data in and data out buffers within individual DRAMs and provided a reference to support that statement (pages 2 and 9 of *DRAM Circuit Design*). Although applicant's reference is not necessary to rejection the present claims, applicant is now contradicting his own arguments by suggesting that data in and data out buffers within individual DRAMs was not obvious.

(D) As to applicant's remarks regarding claims 32, 33, 40 and 42, applicant's piecemeal analysis of Katayama or Rosich is inappropriate. The rejection clearly specifies a *combination* of the two references. As stated above in the rejection, applicant's quoted claim language describes *exactly* how the Katayama et al./Rosich et al. combination would look if it were integrated in the manner described by the examiner.

(E) As to applicant's remarks regarding claims 34-37 and 64, these are not understood, since there is no claim 1 pending in this application.

(F) As to applicant's remarks regarding claims 38-39, 41 and 43 the command and data packets will always experience delays when passing through the buffers.

There is no protocol in existence wherein a buffer operates without an associated delay. This has been described above in the rejection.

(G) As to applicant's remarks regarding claims 44-55, 57-58, 65 and 67-71, the rejection explicitly states that "both of the Rosich et al. buffers are *internal* to the DRAM (in fact, every element shown in Figure 1 is contained within DRAM 100)".

Furthermore, applicant has already stated *on the record* that it was well known to include data in and data out buffers within individual DRAMs and provided a reference to support that statement (pages 2 and 9 of *DRAM Circuit Design*, note Figure 1.1). Although applicant's reference has not been used in the rejection, applicant is now contradicting his own arguments by suggesting that data in and data out buffers within individual DRAMs was not obvious.

Note that claim 65 does not depend from claim 52 as stated in the fourth full paragraph of page 19 of the remarks.

(H) As to applicant's remarks regarding claim 56, this has been explained in the rejection above. This is how computers retrieve data. Some prior art systems provided an added redundancy feature to retrieve the same data from more than one location, however, neither of Rosich et al. or Katayama et al. had such redundancy.

(I) Applicant has not contested the rejections of claims 63 and 66.

Conclusion

7. This is a RCE of applicant's earlier Application No. 09/434,082. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL**

even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (703) 305-3824. The examiner may be reached 8:00 am – 9:30 pm, EST, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7239 (Official communications)

or:

(703) 746-7240 (for Informal or Draft communications)

or:

(703) 746-7238 (for After-Final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

B. James Peikari
Primary Examiner
Art Unit 2186

March 7, 2003